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Paper No. 21

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JUL - 1 2003

In re Application of:
BAILLIE *et al.*
Serial No.: 09/138,146
Filed: August 21, 1998
Attorney Docket No.: 2-2

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. §§ 1.182, filed March 28, 2002, requesting withdrawal of the holding of abandonment. The petition has been treated as a petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181. No fee is required.

The petition is **DENIED**.

A final Office action was mailed on December 20, 2000. A request for a three-month extension of time and a Notice of Appeal with the appropriate fees were filed on June 18, 2001. A request for a three-month extension of time and a Request for Continued Examination (RCE) with the appropriate fees were filed on January 24, 2002. A non-final Office action was mailed on March 12, 2002. On April 29, 2002, a Change of Address, Associate Power of Attorney and a response to the non-final action were filed.

Petitioner asserts the RCE and extension of time were timely filed. Petitioner further asserts that the holding of abandonment was erroneous because of the timely filed RCE.

M.P.E.P. § 1215.01 states in part:

Prior to a decision by the Board, if an applicant wishes to withdraw an application from appeal and to reopen the prosecution of the application, applicant can file a request for continued examination (RCE) under 37 CFR 1.114, accompanied by a submission (i.e., a reply responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action) and the RCE fee set forth under 37 CFR 1.17(e). Note that the RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995, design applications, or reexamination proceedings. See 37 CFR 1.114(d)

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and MPEP § 706.07(h), paragraph X, for more details. An appeal brief or reply brief (or related papers) is not a submission under 37 CFR 1.114, unless the transmittal letter of the RCE contains a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. See MPEP § 706.07(h), paragraph II. The filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether the RCE includes the appropriate fee or a submission. Therefore, when an RCE is filed without the appropriate fee or a submission in an application that has no allowed claims, the application will be considered abandoned. To avoid abandonment, the RCE should be filed in compliance with 37 CFR 1.114. See MPEP § 706.07(h), paragraphs I-II. ...

... Applications having no allowed claims will be abandoned. ...

M.P.E.P. § 706.07(h)(X) states in part:

If an RCE is filed in an application after appeal to the Board of Patent Appeals and Interferences but the request does not include the fee required by 37 CFR 1.17(e) or the submission required by 37 CFR 1.114, or both, the examiner should withdraw the appeal pursuant to 37 CFR 1.114. The proceedings as to the rejected claims are considered terminated. Therefore, if no claim is allowed, the application is abandoned....

A review of the application file reveals that the RCE filed on January 24, 2002, after the appeal, does not contain a submission, as required by 37 CFR § 1.114. Also, the application did not have any allowable claimed at the time the RCE was filed. Pursuant to M.P.E.P. §§ 706.07(h)(X) and 1215.01, the application should have been abandon after the filing of the improper RCE.

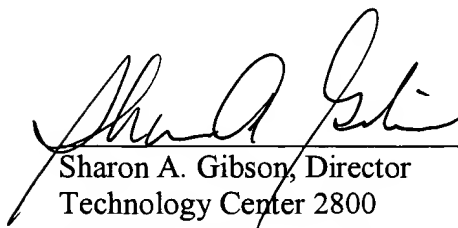
For the above stated reason, the petition is DENIED. The Office action mailed March 12, 2002 was sent in error and is hereby vacated. The application is returned to abandoned status with the date of abandonment of January 28, 2002. The response filed April 29, 2002 will not be entered at this time.

Petitioner may wish to consider filing a petition to the Commissioner under 37 C.F.R. § 1.137, requesting revival of the above identified abandoned application.

In the event that petitioner elects not to file a renewed petition under 37 C.F.R. § 1.137, petitioner may request reconsideration of this decision. Any such request must be filed within 2 (two) months of the date of this decision to be considered timely filed. See 37 C.F.R. § 1.181(f).

The application file wrapper will be held in the Technology Center for 2 months. Afterwards, the file wrapper will be forwarded to file storage.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (703) 308-0519.



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